

REMARKS/ARGUMENTS

The Office Action dated July 21, 2004 has been received and its contents carefully considered. Claims 1-19 are pending. Claims 1-19 have been rejected. Claims 1, 8, and 16-19 have been amended. Claim 15 has been cancelled. Claims 20-24 have been added.

Reconsideration and withdrawal of the outstanding are respectfully requested in view of the following remarks.

CLAIM REJECTIONS – 35 U.S.C. § 102(b)

Claims 1-6, 8-13 and 15-19 were rejected under 35 U.S.C. §102(b) as being anticipated by *Frankovitch, Jr., et al.* Without conceding the propriety of the rejection independent claim 1 and 8 have been amended. Independent claim 15 has been cancelled. It is respectfully submitted that *Frankovitch, Jr., et al.* does not teach, *inter alia*, an oscilloscope adapter for a portable stand alone electronic device comprising “the removable module further adapted to interface with a hardware interface port of the portable stand alone electronic device when the removable module is located in the port for receiving the removable module” as recited in claim 1 of the present invention. It is also respectfully submitted that *Frankovitch, Jr., et al.* does not teach, *inter alia*, a method of causing an electronic device to function as an oscilloscope comprising “connecting the removable adapter module to the hardware interface port by mating the removable adapter module to the receiving port” as recited in claim 8 of the present invention.

Frankovitch, Jr., et al. discloses a measuring device as for displaying waveforms representative of electrical signals including a selector, at least one input terminal, and a graphical display. In the previous Office Action, the Examiner denotes item 10 as shown in FIG. 1 of *Frankovitch, Jr., et al.* as the removable module of the present invention. However, *Frankovitch, Jr., et al.* does teach a removable module in combination with being adapted to

mate with a port of a portable stand alone electronic device for receiving the removable module in combination with a removable module adapted to interface with a hardware interface port of the portable stand alone electronic device when a removable module is located in the port for receiving the removable module, as recited in claim 1 of the present invention. *Frankovitch, Jr., et al.* also fails to teach a method of causing an electronic device to function as an oscilloscope by providing a stand alone electronic device having a port for receiving a removable adapter module and connecting the removable adaptable module to the hardware to the hardware interface port by mating the removable adapter module to the receiving port as recited in claim 8 of the present invention.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, *Frankovitch, Jr., et al.* cannot be said to anticipate the invention as claimed in claims 1 and 8. Hence, withdrawal of the rejection is respectfully requested.

Claims 2-6 depend ultimately from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 9-13 depend from independent claim 8 and are patentable over the cited prior art for at least the same reason as is claim 8.

Claims 15-19 depend ultimately from newly added claims 20. It is respectfully submitted that *Frankovitch, Jr., et al.* does not teach, *inter alia*, a system for causing an electronic device to function as an oscilloscope comprising “means for retaining the removable adapter module to the receiving means to mate the removable module to the interfacing means” as recited in claim 20 of the present invention. Therefore, since each and every element is set forth in the claim is not found either expressly or inherently as described as required by the M.P.E.P. *Frankovitch, Jr., et al.* cannot be said to anticipate the invention as recited in claim 20 of the present invention.

Since claims 15-19 depend ultimately from independent claim 20, it is believed that they are patentable over the cited prior art for at least the same reasons as is claim 20.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

Claims 7 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Frankovitch, Jr., et al.* in view of *Alexander, et al.* Claim 7 depends from independent claim 1. Claim 14 depends from independent claim 8. Claims 1 and 8 of the present invention are patentable over *Frankovitch, Jr., et al.* for at least the same reasons as outlined above.

Alexander, et al. does not cure the deficiencies of *Frankovitch, Jr., et al.*, because it, too, does not teach, *inter alia*, a removable module located in a port of a portable stand alone electronic device for receiving the removable module wherein the removable module is further adapted to interface with the hardware interface port of the portable stand alone electronic device as recited in claim 1 and similarly in claim 8 of the present invention.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Therefore, since the prior art lacks all the claimed features, *Frankovitch, Jr., et al.* alone or in combination with *Alexander, et al.* cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

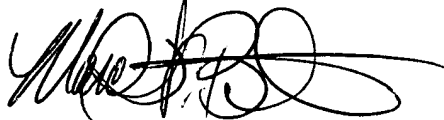
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a large, stylized flourish extending from the end of the signature.

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